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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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03/29/2004

Michael Wayne Crosby

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SUITE 219
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EXAMINER

THOMPSON, MICHAEL M

ART UNIT

PAPER NUMBER

3629

MAIL DATE

DELIVERY MODE

01/23/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/811,615	Applicant(s) CROSBY ET AL.	
	Examiner Michael M. Thompson	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 13-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-7-2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-12 and 19, drawn to a method for a facilitator to assist an Entrepreneur in creating an internet business website, classified in class 705, subclass 1.
 - II. Claims 13-18, drawn to a method for a facilitator to assist an Entrepreneur's website to create business, classified in class 705, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

Inventions II. and I. are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I. has separate utility such as a process for facilitating web site creation and design. Subcombination has separate utility as a process for using any web site to facilitate business transactions. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a

Art Unit: 3629

continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement

Art Unit: 3629

may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Stewart Womack on January 16, 2009 a provisional election was made without traverse to prosecute the invention of claims 1-12 and 19 . Affirmation of this election must be made by applicant in replying to this

Art Unit: 3629

Office action. Claims 13-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-12 and 19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The first step in determining whether a claim recites patent eligible subject matter is to determine whether the claim falls within one of the four statutory categories of invention recited in 35 USC 101: process, machine, manufacture and composition of matter. The latter three categories define "things" or "products", while a "process" consists of a series of steps or acts to be performed. For purposes of 101, the analysis of a process is guided by the machine-or-transformation test. *In re Bilski*, ___ F.3d ___ (Fed. Cir. 2008)(en banc).

Based on Supreme Court precedent (*Diamond v Diehr*, 450 U.S. 175,184 (1981); *Parker v. Flook*, 437 US 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent precedent from

Art Unit: 3629

the Federal Circuit from *In re Bilski*, the machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See *Benson*, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by *Benson*, *the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility*. See *Benson*, 409 U.S. at 71-72. Second, *the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity*. See *Flook*, 437 U.S. at 590. If neither of these requirements is met by the claim, the method is not a patent eligible process under 35 U.S.C. 101.

Claims 1-12 and 19 are drawn to **a method for a Facilitator to assist an Entrepreneur in creating an Internet Business**. All of the recited method steps can be performed by the user themselves, in the mind of the user or between different users through writing by a user or to other user's, while the potential for an implied technology does not place meaningful limitations of the claim's scope. Given the broadest meaningful interpretation, the scope of Applicant's claims appear to be directed to the creation of a web site and assisting the Entrepreneur in designing the web site. These limitations could conceivably be derived through collaboration as stated above, while any implied machine merely loads the *created product* and does not place meaningful limits on the creation nor assists in the design of the web site. (i.e. creation and assistance may be on paper by a person). Furthermore, any involvement of an implied

Art Unit: 3629

machine is insignificant, in as much as, the steps of creation and assistance is involved since the loading of the created product by an implied machine is merely a conduit upload and/or to eventually display the code. Therefore, the limitations of claims 1, 7, and 19 appear to involve a machine merely for insignificant extra-solution activity. In conclusion, these method steps are not adequately tied to a particular machine nor do they transform an article. In the least, to qualify as a statutory process, the claim should positively recite in the body of the claim, the particular machine to which it is tied and should impose a meaningful limit on the claim's scope. Furthermore, the machine must not be involved in an insignificant way as to be characterized as extra-solution activity.

Please note that ***nominal or insignificant recitations of a machine in an otherwise ineligible method fail to make the method a statutory process.*** See Benson, 409 U.S. at 70 -72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). Incidental physical limitations, such as data gathering, field of use limitations, storing, collecting, sending, receiving, displaying, and other forms of insignificant extra solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of involvement of a machine or transformation in a method claim do not convert an otherwise ineligible claim into an eligible one. *Ex parte Langemyr* (2008) and *In re Bilski*, (Fed. Cir. 2008).

Therefore, the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the

Art Unit: 3629

Supreme Court and clarified herein, and Applicants' claim here appears to fail this test.

No new matter should be added.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen (US 6,263,352).

6. **With respect to claims 1, 7 and 19**, Cohen teaches a method for a Facilitator to assist an Entrepreneur in creating an Internet business, comprising the steps of: creating a Facilitator's web site on the Internet accessible to Entrepreneurs (i.e. shown in Figure 4 and the description of Figure 1 as to the general role of the Page Generation System to include Figure 3, at least under the second scenario if not the first, as an overall "Facilitator's web site); receiving information regarding an Entrepreneur that has accessed the Facilitator's web site (i.e. shown in col.6 at least the proposition that access of the Facilitator occurs and information is received when sent by the merchant using its services); storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site (i.e. shown at least in col. 6 for the proposition that the information sent and received is stored at the ISP computer in the builder module or the stored data file 126); assisting an Entrepreneur on the Facilitator's web site in designing an Entrepreneur's web site by providing web site design services

Art Unit: 3629

using at least some of the stored information regarding the Entrepreneur (i.e. shown at least at col. 6 when the Entrepreneur's/merchant's web site is assisted in design by the ISP merchant computer using the builder module and in the descriptions of Figures 5 and 6 discussing the Store Builder Wizard or SBW); and assisting the Entrepreneur on the Facilitator's web site in designing a store front web site using at least some of the stored information regarding the Entrepreneur, wherein the Entrepreneur's web site and the store front web site are designed using substantially similar templates (i.e. this can be shown from the SBW's assists the merchant through a series of templates by the input of information into the store builder module providing the ability to create a store front web site from the same template through the use of the active server templates or AST's and the active server pages or ASP's as described in Figures 5-8, col. 7 and 8. Similarly, it may be argued that the templates themselves produce "substantially similar" templates). Furthermore, the "wherein" statement raises questions as to the limiting effect of the language that follows it and does not appear to limit the claim language. In particular, Applicant's "wherein" language suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. See *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), discussing the similar term "whereby" where the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited."

Art Unit: 3629

7. **With respect to claims 2 and 8**, Cohen teaches the method of claim 1 and 7 respectively, wherein the Entrepreneur's web site and the store front web site have substantially similar appearing navigational bars located in a substantially similar location. (i.e. the Entrepreneur's/merchant's web site created in the stored data file/AST's on the ISP computer is going to contain the hypertext language and scripting language of the merchant's web site. This language or AST comprised of the Entrepreneur/merchant data in the data file and templates comprising the Entrepreneur or merchant's web site, are identical to the ASP executed on the store front generated web site and will therefore contain substantially similar features throughout. Similarly, it may be argued that the templates themselves will produce "substantially similar" web site features between the created web site and the store front at a "substantially similar location.") Furthermore, as to the limitation of navigational bars, the specific type of web site feature (i.e. navigation bars) are deemed to be nonfunctional descriptive material and are not functionally involved in the steps recited. The creating, receiving, storing and assisting steps would be performed the same regardless of what type of web site feature is being created. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

8. **With respect to claims 3 and 9**, Cohen teaches the method of claim 1 and 7 respectively, wherein the Entrepreneur's web site and the store front web site have logos located in substantially similar locations. As per claims 3 and 9, while the

Art Unit: 3629

particular feature may address logos, these claims are rejected under a similar rationale as applied to claims 2 and 8 supra. Furthermore, as to the limitation pertaining to the logos, this specific type of web site feature (i.e. logos) are deemed to be nonfunctional descriptive material and are not functionally involved in the steps recited. The creating, receiving, storing and assisting steps would be performed the same regardless of what type of web site feature is being created. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

9. **With respect to claims 4 and 10**, Cohen teaches the method of claim 1 and 7 respectively, wherein the Entrepreneur's web site and the store front web site have graphical images located in substantially similar locations. As per claims 4 and 10, while the particular feature may address graphical images, these claims are rejected under a similar rationale as applied to claims 2 and 8 supra. Furthermore, as to the limitation of graphical images, the specific type of web site feature (i.e. graphical images) are deemed to be nonfunctional descriptive material and are not functionally involved in the steps recited. The creating, receiving, storing and assisting steps would be performed the same regardless of what type of web site feature is being created. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

Art Unit: 3629

10. **With respect to claims 5 and 11**, Cohen teaches the method of claim 1 and 7 respectively, wherein the Entrepreneur's web site and the store front web site have similar textual content located in substantially similar locations (i.e. col. 5 code addressing text). As per claims 5 and 11, while the particular feature may address textual content, these claims are rejected under a similar rationale as applied to claims 2 and 8 supra. Furthermore, as to the limitation of textual content, the specific type of web site feature (i.e. textual content) are deemed to be nonfunctional descriptive material and are not functionally involved in the steps recited. The creating, receiving, storing and assisting steps would be performed the same regardless of what type of web site feature is being created. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

11. **With respect to claims 6 and 12**, Cohen teaches the method of claim 1 and 7 respectively, wherein the Entrepreneur's web site and the store front web site include a substantially similar color scheme (i.e. Figure 8 deals with style and color; col. 5 in the code). As per claims 6 and 12, while the particular feature may address color schemes, these claims are rejected under a similar rationale as applied to claims 2 and 8 supra. Furthermore, as to the limitation of a color scheme, the specific type of web site feature (i.e. color schemes) are deemed to be nonfunctional descriptive material and are not functionally involved in the steps recited. The creating, receiving, storing and assisting steps would be performed the same regardless of what type of web site feature is being

Art Unit: 3629

created. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) and MPEP 2106.01.

Conclusion

12. The Examiner has pointed out particular references contained in the prior art of record, within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael M. Thompson whose telephone number is (571) 270-3605. The examiner can normally be reached on Monday thru Friday 8am-5:30 except Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3629

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M Thompson/
Examiner, Art Unit 3629

/John G. Weiss/
Supervisory Patent Examiner, Art Unit 3629